

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 2428)

In re Application of:)	
)	
Dae-Sik Oh)	
)	Group Art Unit 2618
Serial No. 10/753,941)	
)	Examiner: Bobbak Safaipoor
)	
Filed: January 7, 2004)	
)	Confirmation No. 5516
For: Radio Frequency Repeater)	
Repeater With Automated)	
Block/Channel Selection)	

Mail Stop **Patent Ext.**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705 (b)-(d)

Sir:

Responsive to the Issue Notification mailed December 29, 2008, Applicant submits this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(b)-(d). Thus, this request complies with the deadline specified in 37 C.F.R. 1.705(d), and Applicant submits that this request is timely.

The Notice of Allowance was mailed October 14, 2008. On November 24, 2008, before Applicant paid the issue fee, Applicant petitioned the Office to request reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(b)-(d) in light of the recent ruling in *Wyeth v. Dudas*, No. 07-1492, slip op. (D.D.C. Sept. 30, 2008). Thus, Applicant's Petition complied with the deadline specified in 37 C.F.R. 1.705(b), and Applicant submits that Applicant's Petition was timely.

On December 11, 2008, the Office mailed a Petition Decision to Applicant, informing Applicant that the request has been held in abeyance until the patent issued. On January 20, 2009, the patent issued. Accordingly, Applicant respectfully requests that the Office now reconsider Patent Term Adjustment for the issued patent, in accordance with the Patent Term Adjustment calculations set forth in *Wyeth v. Dudas*.

The Determination of Patent Term Adjustment indicates that this matter has been granted a 837 day Patent Term Adjustment. Applicant submits that, due to the recent *Wyeth* decision, the correct Patent Term Adjustment should be 1317 days. Applicant, therefore, requests that this matter be granted an additional 480 days of patent term.

Applicant agrees with the Patent Office's initial determination, which, for purposes of this request and in keeping with the explanation provided in *Wyeth*, Applicant will refer to as the "A delay." In the "A delay" the Patent Office delayed prosecution by issuing the first communication 14 months plus 753 days after the filing of the application (37 CFR 1.703(a)(1)) and further delayed prosecution by issuing the Non-Final Rejection mailed on May 29, 2008 4 months plus 84 days after filing of a response (37 CFR 1.703 (a)(2)). Therefore the Patent Office was responsible for a total of 837 days delay.¹

The Patent Office however has **not** included in the Patent Term Adjustment the days related to the "B delay," which are the days delay resulting from an application pending longer than three years. According to 37 C.F.R. 1.703(b):

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage

¹ Note that Applicant delayed prosecution by filing a response 3 months plus 38 days after the mailing of the respective Final Office Action. The Patent Office did not consider this delay in the "A delay" calculation. Applicant believes that Applicant's delay was not considered because it occurred during a pre-appeal brief process.

commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued...

The instant application was filed on January 7, 2004 and the Notice of Allowance was mailed October 14, 2008, which is 3 years plus 646 days after the filing date, resulting in a "B delay" of 646 days.

The *Wyeth* decision states that "the 'A period' and 'B period' overlap only if they occur on the same calendar day or days" (*Wyeth*, No. 07-1492, slip op. at 8). Thus, according to the *Wyeth* decision, Patentees are entitled to both the "A delay" of 837 days and the "B delay" of 646 days minus any overlap which occurs on the same calendar days. There is an overlap of 82 same calendar days between the "A delay" and the "B delay" for the time period of January 7, 2007 to March 30, 2007. Furthermore, there is an overlap of 84 days from March 6, 2008 to May 29, 2008. Thus, the total Patent Term Adjustment due to both the "A" and "B" delays and minus the overlap is 1317 days ($837 + 646 - 82 - 84 = 1317$).

For these reasons, the Patent Term Adjustment for this case should be 1317 days. In light of the foregoing, Applicant respectfully requests that an additional 480 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 1317 days. If a telephone conference would expedite the prosecution of this Request for Reconsideration of Patent Term Adjustment, please contact the undersigned agent as indicated below.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

Date: February 23, 2009

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